

ESTTA Tracking number: **ESTTA566636**

Filing date: **10/23/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Imperial Tobacco Limited
Granted to Date of previous extension	10/23/2013
Address	121 Winterstoke Road Bristol, BS3 2LL UNITED KINGDOM
Domestic Representative	BREWSTER TAYLOR ATTORNEY STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314 UNITED STATES BTAYLOR@STITES.COM Phone:703-739-4900

Applicant Information

Application No	85363520	Publication date	06/25/2013
Opposition Filing Date	10/23/2013	Opposition Period Ends	10/23/2013
Applicant	K. Hansotia & Co., Inc. Bay #5 3705 N.W. 115 Avenue Miami, FL 33178 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: cigars

Applicant Information

Application No	85363542	Publication date	06/25/2013
Opposition Filing Date	10/23/2013	Opposition Period Ends	
Applicant	K. Hansotia & Co., Inc. Bay #5 3705 N.W. 115 Avenue Miami, FL 33178 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: cigars

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Lack of good faith intent to use the mark.

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	IMPERIAL TOBACCO LIMITED; IMPERIAL TOBACCO; IMPERIAL TOBACCO GROUP; IMPERIAL; IMPERIAL TOBACCO COMPANY; IMPERIAL GROUP		
Goods/Services	Tobacco Products		

Attachments	consolidated notice of opposition.pdf(1942055 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/bt/
Name	BREWSTER TAYLOR
Date	10/23/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**IN THE MATTER OF TRADEMARK
APPLICATION SERIAL NOS. 85/363,542 and
85/363,520**

IMPERIAL TOBACCO LIMITED

Opposer

v.

K. HANSOTIA & CO., INC.

Applicant

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Opposition No.

CONSOLIDATED NOTICE OF OPPOSITION

IMPERIAL TOBACCO LIMITED, a limited company organized under the laws of England and Wales with a principal address at 121 Winterstoke Road, Bristol, BS3 2LL, United Kingdom (hereinafter "Opposer"), believes that it would be damaged by registration of the marks "IMPERIAL TOBACCO CORPORATION" (Serial No. 85/363,542) and "IMPERIAL WRAPS" (Serial No. 85/363,520) for "cigars" in the name of **K. HANSOTIA & CO., INC.**, a corporation organized under the laws of Florida, with a principal place of business at Bay # 5, 3705 N.W. 115 Avenue, Miami, Florida (hereinafter "Applicant"), and Opposer, by its undersigned attorneys, hereby requests that registration of the marks be denied on the following grounds:

1. In U.S. Application Serial No. 85/363,542, Applicant seeks registration of the alleged mark "IMPERIAL TOBACCO CORPORATION" for "cigars". The application was filed on July 5, 2011, and is based on Applicant's alleged intent to use the mark in commerce in connection with said goods under Section 1(b) of the Trademark Act (15 U.S.C. §1051(b)).

2. In U.S. Application Serial No. 85/363,520, Applicant seeks registration of the alleged mark "IMPERIAL WRAPS" for "cigars". The application was filed on July 5, 2011, and is based on Applicant's alleged intent to use the mark in commerce in connection with said goods under Section 1(b) of the Trademark Act (15 U.S.C. §1051(b)).

3. Opposer has used "IMPERIAL TOBACCO LIMITED" as a mark and name in connection with tobacco products sold in commerce in the U.S. since long prior to the filing of the applications for registration of "IMPERIAL TOBACCO CORPORATION" and "IMPERIAL WRAPS" and, on information and belief, since long prior to any actual use of those alleged marks by Applicant. Through years of sales and advertising of tobacco products in commerce, the name and mark "IMPERIAL TOBACCO LIMITED" has become exclusively associated with Opposer.

4. Through years of advertising and publicity, such other names and/or marks used by Opposer as "IMPERIAL TOBACCO" and "IMPERIAL TOBACCO GROUP" have also become exclusively associated with Opposer in connection with a variety of tobacco products sold in the United States. Further, as the result of publicity and third party use, Opposer has also been referred to, known, and recognized as "IMPERIAL", "IMPERIAL TOBACCO COMPANY" and "IMPERIAL GROUP". Through years of activities and publicity involving its marks and/or names in the United States, Opposer has developed considerable good will and customer recognition in these marks and/or names for tobacco products since long prior to the filing of the applications for registration of "IMPERIAL TOBACCO CORPORATION" and "IMPERIAL WRAPS" and, on information and belief, long prior to any actual use of the alleged marks by Applicant.

5. Since Applicant's alleged marks "IMPERIAL TOBACCO CORPORATION" and "IMPERIAL WRAPS" for "cigars" are very similar to Opposer's prior used "IMPERIAL TOBACCO" marks and/or names and the names, including "IMPERIAL" alone, used by others to refer to Opposer, and since the products allegedly to be sold by Applicant under these very similar alleged marks are highly related to the products sold by Opposer, known also as "IMPERIAL", under its "IMPERIAL TOBACCO" names and/or marks, purchasers are likely to be confused as to the source of the products and to mistakenly attribute them to the same source.

6. Any defects, objections or faults found with Applicant's products if they are sold under its alleged marks could inflict upon and seriously injure the reputation of Opposer and the good will established over the years in its "IMPERIAL TOBACCO" marks and/or names.

7. The grant of a registration to Applicant of its alleged marks "IMPERIAL TOBACCO CORPORATION" and "IMPERIAL WRAPS" would be in derogation of Opposer's prior rights and thereby cause damage and injury to Opposer and cause confusion of the relevant purchasing public.

8. Applicant's alleged marks "IMPERIAL TOBACCO CORPORATION" and "IMPERIAL WRAPS" so resemble Opposer's previously used "IMPERIAL TOBACCO" marks and/or names as to be likely, if used in connection with Applicant's goods, to cause confusion, mistake or deception and thereby fall within the proscription of Section 2(d) of the statute, 15 U.S.C. § 1052(d) and should be denied registration.

9. On information and belief, the good faith of Applicant's alleged good faith intent to use the purported marks in commerce for "cigars" is not apparent, and Opposer challenges the nature and sufficiency of Applicant's alleged intent to use the purported marks in commerce. On information and belief, while Applicant has demonstrated an intent to trade on Opposer's well-

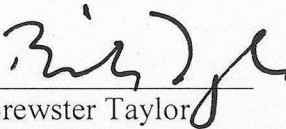
known names and/or marks, Applicant does not have a good faith intent to use "IMPERIAL TOBACCO CORPORATION" and "IMPERIAL WRAPS" as marks for "cigars".

WHEREFORE, Opposer believes that it would be damaged by grant to Applicant of registration on Application Serial Nos. 85/363,542 and 85/363,520 and prays that its opposition be sustained and that registration be denied.

Respectfully submitted,

STITES & HARBISON PLLC

October 23, 2013

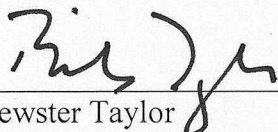

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing CONSOLIDATED NOTICE OF OPPOSITION was served on counsel for Applicant, this 23rd day of October, 2013, by sending it via First Class Mail, postage prepaid, to:

Pablo Meles, Esq.
Guntin, Meles & Gust PLC
750
304 Indian Trace
Weston, Florida 33326


Brewster Taylor